

SK

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SV

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/427,892 10/26/99 WEIFFEN R 4452-263

PM82/0111

THOMAS C PONTANI ESQ
COHEN PONTANI LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK NY 10176

EXAMINER

WILLIAMS, T

ART UNIT

PAPER NUMBER

3613

5

DATE MAILED: 01/11/01

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/427,892

Applicant(s)

WEIFFEN ET AL.

Examiner

Thomas J. Williams

Art Unit

3613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. Acknowledgment is made in the receipt of the declaration and the priority documents received January 3, 2000.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number 100 does not appear in the figures. Correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4, 5 and 10 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the fact that the applicant has not disclosed the manner in which the damping valve achieves a pre-controlled setting, which depends upon whether the vibration damper is in a compression state or a rebound state.

Claim Rejections – 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3613

6. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,035,306 to Ashiba.

Re-claim 1, Ashiba discloses a vibration damper, comprising: a working cylinder 2; a piston (viewed as the combination of elements 3, 6, and 7) fastened to a piston rod 10 and dividing the working cylinder into two working spaces; first and second non-return valve 21 and 22; a damping valve 33 having a variable damping action and arranged in series with the first and second non-return valves. It is well known that the amount of current applied to a solenoid will control the position of an armature associated with a valve element.

Re-claim 2, the damping valve of Ashiba is externally controlled by an actuator.

Re-claim 3, the first and second non-return valves of Ashiba are spring loaded disc valves.

Re-claims 4, 5, and 10, the damping valve of Ashiba is electromagnetically controlled and will have a pre-controlled setting when current is not applied to the solenoid. The pre-controlled setting is seen as a closed position of the valve against the valve seat.

Re-claims 6-8, the first and second non-return valves of Ashiba are accommodated together in the piston and are arranged as a modular unit fixed within the piston.

Re-claim 9, the first and second non-return valves of Ashiba communicates the lower working space and the damping valve actuates a flow connection to the upper working space.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shimakura ('877), Oster et al. ('228), Beck ('640), Rubel ('461), Kobayashi et al.

Art Unit: 3613

('180), Ackermann et al. ('241), Ashiba ('385), Reeves et al. ('375), Forster et al. ('540) all disclose a controllable damping valve in series with first and second non-return valves.


8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is (703) 305-1346. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Oberleitner, can be reached at (703) 308-2569. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

TJW

January 9, 2001


DOUGLAS C. BUTLER
PRIMARY EXAMINER
AU 3613

1/16/01